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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,191	08/21/2003	Andrew Thurkauf	58289 (72021)	1037
21874	7590	01/11/2006	EXAMINER	
EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205			SAEED, KAMAL A	
		ART UNIT	PAPER NUMBER	
			1626	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,191	THURKAUF ET AL.	
	Examiner	Art Unit	
	Kamal A. Saeed	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10/20/2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 36-44 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) 32-35 and 45-47 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/21/03 & 4/19/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

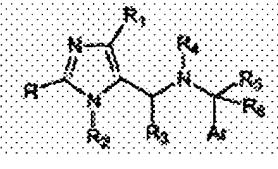
Claims 1-47 are pending in this application. Claims 36-44 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

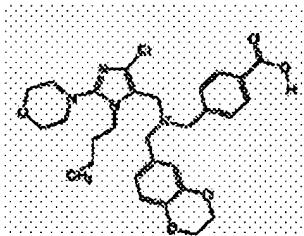
Information Disclosure Statement

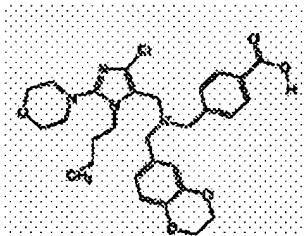
Applicant's Information Disclosure Statements, filed on 21 August 2003 and 19 April 2004 have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Response to Restriction

Applicants' election of Group I, claims 1-35 and 45-47 (all claims in part), drawn to the

compounds represented by formula (I),  , and specific compound 15,

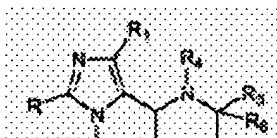


 , provided in table 1, on page 64 of the specification in response filed on 20 October 2005 is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, the restriction requirement is deemed proper.

In accordance with M.P.E.P. 821.04 and In re Ochiai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims and method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process is deemed proper.

Scope of the Elected and Examined Subject Matter:

The scope of the invention of the elected subject matter is as follows:



Compounds of formula I, , depicted in claim 1, wherein:

R represents:

heterocycloalkyl, which is optionally substituted;

R₁ represents:

(i) hydrogen, hydroxy, halogen, amino, cyano, nitro, C₁-C₆haloalkyl or C₁-C₂haloalkoxy;

(ii) C₁-C₆alkyl, C₂-C₆alkenyl, C₂-C₆alkoxy, C₂-C₆cycloalkyl, (C₂-C₆cycloalkyl)C₁-C₆alkyl, or mono- or di-C₁-C₆alkylamino R₂ is optionally substituted C₁-C₆alkyl or optionally substituted C₂-C₆alkenyl; or

(iii) phenylC₀-C₄carbonyl or (5- or 6-membered heteroaryl)C₀-C₄carbonyl, each of which is optionally substituted;

R₃ is hydrogen or C₁-C₆alkyl;

R₄ represents:

(i) optionally substituted arylC₀-C₂alkyl having 1 ring or 2 fused rings; or
 (ii) optionally substituted arylC₁-C₆alkyl, wherein the aryl portion is fused to a 5- to 7-membered saturated or partially unsaturated ring having 0, 1 or 2 ring atoms independently chosen from N, O and S, with remaining ring atoms being carbon;

R₅ and R₆ are independently chosen from hydrogen and C₁-C₆alkyl; and

Ar represents:

(i) optionally substituted aryl having 1 ring or 2 fused or pendant rings; or
 (ii) optionally substituted phenyl fused to a 5- to 7-membered saturated or partially unsaturated ring having 0, 1 or 2 ring atoms independently chosen from N, O and S, with remaining ring atoms being carbon.

As a result of the election and the corresponding scope of the invention identified *supra*, the remaining subject matter of claims 1-35 and 36-44 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as triazine, homopiperazinyl, thiomolpholinyl, propylaminy1 etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 subclass 63(+) (thiomorpholine), class 540 subclass 450(+) (homopiperzinyl), class 544 subclass 180(+) (triazines), 548 subclass 400(+) pyrrolidines etc. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,884,815 B1, since the claims, if allowed, would improperly extend the “right to exclude” already granted in the patent. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to the same art recognized subject matter. A reference anticipating one set of claim will render the other obvious and it would have been obvious to one of ordinary skill in the art at the time of the invention was made since US Patent No. '815 teach the generic compound of the instantly claimed compound. The instant claims differ from the reference by reciting a specific species and a more limited genus than the reference. The instant compound is so closely related structurally to the analogous compound of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. One of ordinary skill in the art would be motivated to prepare the compound since there is an exemplary teaching to prepare the claimed compound in the prior art. The motivation to make the claimed compound derives from the expectation that structurally similar compounds are generally expected to have similar properties and have similar utilities. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979). Applicants should note that a generic teaching is grounds for obvious type double patenting rejection. In looking at the instantly claimed compound as a whole, the claimed compound and its uses would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

Objections

Claims 1-35 and 45-47 are objected to for containing non-elected subject matter.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

K. Saeed
KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER